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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,879	04/05/2001	Daniel Patrick Connors	Y OR920000070	3754
21254	7590	07/27/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			O'CONNOR, GERALD J	
		ART UNIT		PAPER NUMBER
				3627

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/825,879	Connors et al.	
	<b>Examiner</b>	<b>Art Unit</b>	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on May 11, 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 and 21-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on May 17, 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### *Preliminary Remarks*

1. This Office action responds to the amendment and arguments filed by applicant on May 11, 2005 in reply to the previous Office action, mailed February 11, 2005.
  
2. The amendment of claims 1 and 3, cancellation of claims 14-20, and addition of claims 21-27, in the reply filed by applicant on May 11, 2005, are hereby acknowledged.

### *Election/Restriction*

3. Newly submitted claim 27 is directed to an invention (Invention II) that is independent or distinct from the invention originally claimed (Invention I) for the following reasons:

Invention II is related to Invention I as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, *and* (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In this case, the combination as claimed does not require the particulars of the subcombination as claimed because a system in accordance with Invention II need not be capable of remotely causing the shelf label holder to illuminate under a predetermined condition. The subcombination has separate utility by itself (i.e., without any host controller).

4. Since applicant has received an Office action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly presented claim 27 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brick et al. (US 6,269,342), in view of Adamec et al. (US 6,211,773).

Brick et al. disclose a system for restocking and repricing merchandise, comprising: a shelf label holder; and a hand-held unit which remotely programs said shelf label holder, but the shelf label holder of Brick et al. fails to include an illuminating section which is illuminated by remote control of the hand-held unit under a predetermined condition. However, Adamec et al. disclose a similar system for restocking and repricing merchandise, and the shelf label of Adamec et al. indeed includes a plurality of illuminating sections which are illuminated by remote control of the hand-held unit under a predetermined condition (see, in particular, column

4, line 32 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Brick et al. so as to include an illuminating section in the shelf label which would be illuminated by remote control of the hand-held unit under a predetermined condition, in accordance with the teachings of Adamec et al., in order to facilitate locating the shelf label to be programmed.

Regarding claim 2, the system of Brick et al. includes a host controller for storing merchandise data and planogram data, processing said data and remotely controlling an operation of said hand-held unit and said shelf label holder.

Regarding claims 3 and 24-26, the shelf label holder of Brick et al. includes a shelf control unit, and the shelf label holder of Adamec et al. includes a shelf control unit for controlling an illumination of the shelf label holder; with the illuminating section illuminating as directed by the shelf control unit. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Brick et al. so as to include that the shelf control unit would control illumination of the shelf label holder; with the illuminating section illuminating as directed by the shelf control unit, in accordance with the teachings of Adamec et al., in order to provide a convenient means of enabling the illumination section of the shelf label to be controlled.

Regarding claim 4, the system of Brick et al. includes that an identifying section of said shelf label is inserted into said shelf control unit.

Regarding claim 5, the system of Brick et al. includes that the shelf control unit comprises: a receptacle for receiving said identifying section of said shelf label; and a transceiver for transmitting signals to said host controller and said hand held unit and receiving signals from said host controller and said hand held unit.

Regarding claim 6, the system of Brick et al. includes that the hand-held unit comprises: a transceiver for transmitting signals to said host controller and said shelf control unit and receiving signals from said host controller and said shelf control unit; a display device for displaying merchandise data and planogram data; at least one of a bar code scanner and a keypad for inputting said data into said hand held unit; and a memory for storing said data.

Regarding claim 7, the system of Brick et al. includes that the host controller comprises: a memory for storing planogram data and merchandise data; a display device for displaying said data; at least one of a bar code scanner and a keypad for inputting said data; and a transceiver for transmitting signals to said shelf control unit and said hand held unit and receiving signals from said shelf control unit and said hand held unit.

Regarding claim 8, the system of Brick et al. includes that the merchandise information comprises vendor information data, pricing data and inventory data, and wherein said planogram data comprises correct merchandise shelf locations.

Regarding claim 9, the system of Brick et al. includes that the host controller transmits planogram data and merchandise data to said hand held unit and said hand held unit displays said data (see, in particular, column 14, line 3 et seq.).

Regarding claim 10, the system of Brick et al. includes that the identifying section comprises at least one of a bar code, a radio frequency identification (RFID) tag, and a magnetic identification tag.

Regarding claim 11, the system of Adamec et al. includes that the illuminating section comprises at least one of a light-emitting diode, an organic light emitting diode, a liquid crystal display element, a plasma display element, an incandescent light bulb, and a light pipe. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the shelf label holder of Brick et al. so as to include that the illuminating section would comprises at least one of a light-emitting diode, an organic light emitting diode, a liquid crystal display element, a plasma display element, an incandescent light bulb, and a light pipe, in accordance with the teachings of Adamec et al., in order to provide a convenient means of providing the illumination for the illumination section.

Regarding claim 12, the system of Brick et al. includes that the signals comprise at least one of a radiowave signal and infrared signal.

Regarding claim 13, the system of Brick et al. includes that the merchandise data comprises merchandise restocking and repricing information.

Regarding claims 21 and 22, the system of Brick et al. includes that the illuminating device comprises LEDs formed along a longitudinal edge of said shelf label holder.

Regarding claim 23, the system of Brick et al. includes that the shelf label holder is connected to one of an upper and lower surface of a shelf for displaying the merchandise.

***Response to Arguments***

7. Applicant's arguments filed May 11, 2005 have been fully considered but are not persuasive.
  
8. Regarding the argument that Brick et al. and Adamec et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the two references are each pertinent to the problem to be solved.
  
9. Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge generally available to one of ordinary skill in the art would be sufficient to offer reasonable and sufficient motivation to combine.

Furthermore, the combination could have been made readily and easily by any person of ordinary skill in the art, at the time of the invention, with neither undue experimentation, nor risk

of unexpected results, and it is well settled that the main test for the tenability of any conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art knowledge is whether or not such a combination or modification could have been performed or implemented by any person of ordinary skill in the art, at the time of the invention, with neither undue experimentation, nor risk of unexpected results. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to the disclosure.

11. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

July 22, 2005



(7-22-05)

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627